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Paper No. 10

In re Application of Solomon

Application No. 09/082,663

Filed: May 21, 1998

Attorney Docket No. 97-125

Title: METHOD AND APPARATUS FOR
EMULATING A DEVICE WITHIN A DATA
PROCESSING SYSTEM

: DECISION DISMISSING PETITION
: TO WITHDRAW HOLDING OF
: ABANDONMENT UNDER 37 CFR
: §1.181(a)
:
:

This is a decision on the petition filed on October 4, 2001 under 37 CFR §1.181 to withdraw the holding of abandonment of the above-identified application.

The application was held abandoned for failure to respond in a timely manner to the Office communication setting a period for reply that was mailed June 5, 2000. The October 2001 petition provides a statement by a representative for applicant; and a copy of docket records for application 09/082, 663. The basis for the petition is on the grounds the Office communication mailed June 2000 was not received.

According to the MPEP §711.03(c), the showing required to establish nonreceipt of an Office action includes the following:

- 1) a statement from practitioner that the Office action was not received,
- 2) a statement from practitioner that the file jacket and docket records were searched,
- 3) a copy of the docket record at the address of record, and
- 4) a reference to the docket record in the practitioner's statement.

A review of the evidence provided in the petition *may be* sufficient to prove nonreceipt of the Office action mailed June 5, 2000. Petitioners have provided all the necessary statements, but the accompanying docket record raises questions requiring further clarification from the practitioner. The practitioner states that a "copy of the *entire* docket record for the subject application showing *all* replies docketed, if any, ... is attached." However, the Notice of Abandonment mailed to the Milpitas address is not logged in even though it is identified through inter-office communications as having been received on March 22, 2001. The evidence provided to date suggests possible lapses in coverage and confusion in-house. Therefore, the evidence is not sufficient to overcome the presumption of receipt, practitioner's statements to the contrary notwithstanding. The practitioner is

requested to provide further clarification regarding the docketing of Office communications in regards to timeframes when persons with primary responsibilities may be absent from the company and in regards to the nature of the docket record provided. Specifically, why that record should be considered accurate when it omits the entry of other papers received.

The docket record also raises the issue of timeliness of the petition. Beginning with the February 6, 2001 entry, in-house and outside counsel appear to be on notice regarding the abandonment of the application. As of March 22, 2001, the Milpitas location appears to confirm receipt of the Notice of Abandonment. However, the petition to withdraw the holding of abandonment was not submitted until October 4, 2001. 37 CFR §1.181(f) provides that any petition not filed within 2 months from the action complained of may be dismissed as untimely. The petition was filed *seven* months from the mail date of the Notice of Abandonment and a terminal disclaimer did not accompany it. However, the requirement to file a terminal disclaimer to overcome this delay is being held in abeyance. The record suggests applicant's representatives intentionally delayed filing a petition since such a recommendation to do so was made as early as March 23, 2001. The intention of the petition process and of terminal disclaimers is not to permit applicants to escape their duty of reasonable diligence. (See, Denny Notice, "Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment," 1124 OG 23.)

The petition is **DISMISSED**.

The application is being forwarded to the art unit. The Office communication will be remailed with the three-month period for reply restarted to run from the date of the remailing.

John Love

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JAB